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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,700	07/11/2006	Anthony Bonnet	FR-AM 2005 NP	6532
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ARKEMA INC. PATENT DEPARTMENT - 26TH FLOOR 2000 MARKET STREET PHILADELPHIA, PA 19103-3222				
EXAMINER				
SELLERS, ROBERT E				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
01/29/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/585,700

## Applicant(s)

BONNET ET AL.

## Examiner

ROBERT SELLERS

## Art Unit

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 5, 9, 15-19, 22, 24 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 20, 21, 23 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. Claims 15, 18, 19 and 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected inventions, there being no allowable generic or linking claim. Claims 5, 9, 16, 17, 22 and 24 are withdrawn as directed to non-elected species. The elections were made **without** traverse in the non-Final rejection mailed October 9, 2008.
2. The obviousness-type double patenting rejection has been overcome by the terminal disclaimer filed January 5, 2009.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 6-8, 10-13, 20, 21, 23 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed.

3. The specification on page 1, line 12 supports the claimed reaction step e by heat alone. However, neither the disclosure nor examples substantiate the reaction via pressure alone. Example 1 (page 10, line 19) and Example 2 (page 10, line 32) only shows a reaction in the presence of both heat and pressure.

The text of section 103(a) of Title 35, U.S. Code not included in this action can be found in the non-Final rejection.

Claims 1, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boisseau et al. Patent No. 6,685,985 and Japanese Patent No. 6-57101.

Claims 1-4, 6-8, 10-13 rejected under 35 U.S.C. 103(a) as being unpatentable over French Patent No. 2,841,252 and Court et al. Patent No. 6,894,113.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the French patent and Court et al. as applied to the claims hereinabove, and further in view of Perez et al. Patent No. 5,709,948.

The rejections are maintained for the reasons of record set forth in the non-Final rejection. The arguments filed January 5, 2009 have been considered but are unpersuasive.

4. The rheology control agent of Boisseau et al. achieves a balance of vertical sag control and horizontal flow (col. 4, lines 5-13).
5. The Japanese patent (Derwent abstract example) shows the preparation of a varnish comprising epoxy resins wherein is added a rheology control agent and phenol novolak curative. Thus, the epoxy resin varnish is separately prepared without the curative.
6. The French patent (CAPLUS and Derwent abstracts) shows the mixing of an epoxy resin, 4,4'-methylenebis(3-chloro-2,6-diethylaniline) curing agent and Butadiene/styrene/methyl methacrylate block copolymer rheology control agent.

7. Court et al. (col. 10, lines 53-64) shows the blending of a bisphenol A diglycidyl ether (i.e. BADGE) and impact modifier such as a styrene-butadiene-methyl methacrylate triblock copolymer SBM3 (col. 10, lines 25-33) recognized as having rheology control properties in the French patent. A diamine hardener is then added due to the recognition that the epoxy-amine reaction occurs during blending (col. 10, lines 61-63).

8. The Japanese patent and Court et al. establish the separate addition of a hardener to an already formed composition containing an epoxy resin. Accordingly, it would have been obvious to formulate the mixtures of the references by separating the epoxy resin from the hardener in order to prevent their reaction until the formation of the desired article.

9. According to MPEP § 2144.01, IV. Rationale Different from Applicant's Permissible:

"The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant (*In re Kahn*, 78 USPQ2d 1329, 1336, Federal Circuit 2006).

Although the motivation to include the rheology control agents of the references to optimize the flowability of the epoxy resin and hardener components prior to mixing is different from the intention of applicants to control the reaction between the epoxide prepolymer and hardener, it remains a valid reason as confirmed by the case law.

10. It cannot be ascertained whether the comparisons between Example 1 and Comparative Example 3 on pages 10-11 of the specification (both using SBM1), and between Example 4 and Comparative Example 6 on pages 11-12 (both utilizing SBM1) are conclusive since the comparative examples employ 41.53 g of BADGE and 18.47 g of MDEA, but the amounts thereof are not identified in Examples 1 and 4.

11. The evidence is not commensurate in scope with the claims regarding the variety of epoxide prepolymers such as novolac polyglycidyl ethers and tetraglycidyl ethers within the broadly claimed epoxide prepolymer (specification, page 4, lines 20-24), the myriad types of hardeners within the broadly claimed hardener (page 4, line 32 to page 5, line 7) and the various kinds of rheology control agents within the broad definition set forth on page 5, lines 8-11. Furthermore, the testing of single proportions of epoxide prepolymer, hardener and first and second rheology control agents does not establish the criticality of the extreme ranges thereof.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

(571) 272-1093 (Fax No. (571)-273-8300)  
Monday to Friday, 9:30 to 6:00

/Robert Sellers/  
Primary Examiner  
Division 1796

rs  
1/26/2009